

Remarks/Arguments

The present amendment is submitted in response to the Office Action dated September 9, 2004, and identified as Paper No. 20040907. Claims 1-32 are pending.

In the action, the Examiner rejected claims 1-32 in view of a defective reissue declaration. Claims 27-28 were rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Claims 23-32 were rejected under 35 U.S.C. 251 as being an improper recapture of subject matter surrendered in the original application for the patent for which reissue is sought. The Examiner also noted that the original patent, or a statement as to loss or inaccessibility must be received. The Examiner noted that an explanation of the support for the changes to claims must be made. Claim 28 was rejected under 35 U.S.C. § 112, first paragraph as being indefinite.

Claims 23-25 and 27-29 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,745,828 to Stepan ("*Stepan*"). Claim 26 was rejected under 35 U.S.C. § 103(a) as obvious over *Stepan* in view of U.S. Patent No. 4,619,164 to Aikens ("*Aikens*"). Claim 30 was rejected under 35 U.S.C. § 103(a) as obvious over *Stepan* in view of U.S. Patent No. 4,993,287 to Carpenter ("*Carpenter*"). Claims 31-32 was rejected under 35 U.S.C. § 103(a) as obvious over *Stepan* in view of U.S. Patent No. 5,272,941 to English et al. ("*English*").

With regard to the rejection based on a defective reissue declaration, Applicant submitted a reissue application stating that "the invention encompasses one or more blades in addition to ***the single blade with a circular cutting edge*** moved in an orbiting path with a circular edge moved in an orbiting path about the workpiece, ***as recited in claim 1 of the patent***, and incorporated by reference in claims 2 through 5. Thus, Applicant identified that the "single blade" limitation in claim 1 (and claims 2-5) could encompass more than one blade operating in

the same manner. This showing of a single particular error is sufficient to satisfy the reissue declaration requirements. MPEP § 1414(II) (“Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based”).

With regard to the rejection of claims 27-28 under 35 U.S.C. § 112, first paragraph, the term “sharp” has been deleted from claim 27, although it should be recognized by one of ordinary skill in the art that “blades” for cutting cable would inherently be sharp (or at least sharp enough to perform the claimed cutting operation).

With regard to the rejection of claims 23-32 as improperly recapturing surrendered subject matter, claim 23 has been amended to recite “comprising first and second linear stepper motors respectively connected to said pair of gripping members,” which was inadvertently omitted from the reissue claims.

With regard to the rejection of claim 28 under 35 U.S.C. § 112, first paragraph, the term “portions” has been deleted from claim 28.

With regard to the rejection of claims 23-25 and 27-29 as anticipated by *Stegan*, claim 23 as amended now contains the limitation that the second motive means comprises “first and second linear stepper motors respectively connected to said pair of gripping members,” which was found to define over the cited art during prosecution of the original application.

As the remaining rejections depend from claim 23, which now recites a limitation entirely absent from the prior art, the remaining claims are believed to be in condition for allowance.

In view of the foregoing, the application is believed to be in condition for the Examiner’s consideration and allowance. If the Examiner believes a phone conference with Applicant’s attorney would expedite prosecution of this application, please contact the undersigned at (315) 218-8515.

Appl. No. 10/798,249
Amendment dated December 7, 2004
Reissue of 6,588,302

Respectfully submitted,

Dated: December 7, 2004

By: 

George R. McGuire
Reg. No. 36,603

BOND, SCHOENECK & KING, PLLC
One Lincoln Center
Syracuse, New York 13202-8530
315-218-8515